

**REMARKS**

Reconsideration and allowance of this application is respectfully requested in light of the following remarks.

**Status of Claims**

Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,602,593 ("Callahan") in view of U.S. Patent No. 5,635,262 ("Best").

**Section 103 Rejection**

The instant invention is rejected, as being obvious, over U.S. Patent No. 6,602,593 ("Callahan") in view of U.S. Patent No. 5,635,262 ("Best"). Applicant traverses this rejection.

Before a reference can be used as invalidating art under 35 USC § 103 it must qualify as prior art under 35 USC §102. 35 USC §102(a) holds:

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent,

The cited reference Callahan USP 6,602,593 was patented after the filing of the instant invention. Therefore Callahan does not qualify as a prior art reference under 35 USC § 102(a).

35 USC §102(b) holds:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States,

Clearly 35 USC §102(b) requires that before a patent is used as prior art it must be patented "more than one year prior to the date of the application for patent in the United States". Now let us look at the primary reference cited by the Office, U.S. Patent No. 6,602,593 of Callahan. Callahan issued on August 5, 2003, the Instant Application was filed in the United States on December 3, 2001 one year, eight months after the filing of the Instant Application. Callahan USP 6,602,593 does not qualify as a prior art reference under 35 USC § 102(b).

35 USC §102(c) holds:

(c) he has abandoned the invention

As Applicants have not abandon their invention this section obviously does not apply.

35 USC §102(d) holds:

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States

This section is not applicable to this case.

35 USC §102(e) holds:

(e) The invention was described in -

- (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
- (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a);

The cited reference Callahan USP 6,602,593 was not published under section 122(b) so that §102(e)(1) is not applicable. Section (2) may apply however 35 USC §103(c) rules out application of this reference as 35 USC §103(c) states:

(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

In the instant case the invention the assignment was filed on January 24, 2002 to Celgard Inc., the assignee of the cited reference Callahan USP 6,602,593, when the invention was made the named inventors were employees of Celgard and had as duty to assign the invention to their employer. Therefore Callahan USP 6,602,593 does not qualify as a prior art reference under 35 USC § 102(e).

35 USC §102(f) holds:

(f) he did not himself invent the subject matter sought to be patented, or

As the office makes no reference to these facts they do not apply, however as both the instant invention and Callahan USP 6,602,593 are owned by Celgard 35 USC §103(c) rules out application of this reference.

35 USC §102(g) holds:

(g) (1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or

(2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned,

suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other

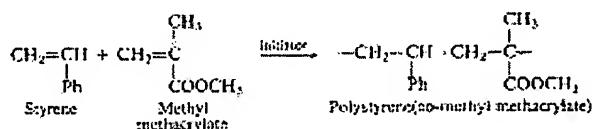
The instant invention is not the subject of an interference so that 35 USC §102(g) should not apply, however as both the instant invention and Callahan USP 6,602,593 are owned by Celgard 35 USC §103(c) rules out application of this reference in an obviousness rejection.

For the reasons listed above Callahan does not qualify as a prior art reference under 35 USC § 103 as section (c) precludes the use of a reference "which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." Therefore the objection to the claims under 35 USC § 103 should be dropped and the claims allowed.

Applicants note that even if Callahan would have qualified as a prior art reference under 35 USC § 102(a) or (b) the rejection under 35 USC § 103(a) would still be improper. It is the Office's position that the instant Callahan teaches use of polymers selected from polypropylene, polyethylene and copolymers thereof that Callahan does not teach addition of an elastomer but some of the co-polymers of polypropylene, polyethylene are classified as elastomers and therefore the instant invention is obvious.

Applicants traverse. In Organic Chemistry by Morrison and Boyd, 3<sup>rd</sup> Edition, copyright 1973, at page 1033 defines copolymerization as:

Now, if a mixture of two (or more) monomers is allowed to undergo polymerization, there is obtained a **copolymer**: a polymer that contains two (or more) kinds of monomeric units in the same molecule. For example:



Through copolymerization there can be made materials with different properties than those of either homopolymer, and thus another dimension is added to the technology. Consider, for example, styrene. Polymerized alone, it gives a good electric insulator that is molded into parts for radios, television sets, and automobiles. Copolymerization with butadiene (30%) adds toughness; with acrylonitrile (20-30%) increases resistance to impact and to hydrocarbons; with maleic anhydride yields a material that, on hydrolysis, is water-soluble, and is used as a dispersant and sizing agent. The copolymer in which butadiene predominates (75% butadiene, 25% styrene) is an elastomer, and since World War II has been the principal rubber substitute manufactured in the United States.

What is clear is that copolymerization of the starting materials produce compounds that have a variety of properties. While it may be true that polypropylene can be copolymerized with ethylene to create EPR there is no teaching or suggestion in the Callahan to do so. Callahan provides no guidance as to what properties are to be sought from the copolymers it teaches can be used. The only way to arrive at the present invention is to use hindsight from the instant application and selectively pick and choose from references which contain no motivation for combination and combine the references. The Best reference teaches use of an elastomer composition with a high molecular weight high density polyethylene to be used as grocery bags or t-shirt bags. Best fails to teach or suggest that it composition be used with micro-porous films or battery separators.

The Federal Circuit has repeatedly warned that the requisite motivation must come from the prior art, not applicant's specification. See *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531-1532 (fed. Cir. 1988). "There must be a reason or suggestion in the art for selecting the procedure used, other than the knowledge learned from the applicant's disclosure." Using an applicant's disclosure as a blue print to reconstruct the claimed invention from isolated pieces of the prior art contravenes the statutory mandate section 103 of judging obviousness at the point in time when the invention was made. See *Grain Processing Corp. v. American Maize-Prod. Co.*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

With respect to the rejection under 35 USC §103 the rejection Callahan USP 6,602,593 cannot be a reference as it is owned by the same entity. However even if Callahan USP 6,602,593 was a proper reference, the obviousness type rejection must fail as it represents improper hindsight reconstruction. Applicants respectfully request that the rejection to the claims be withdrawn, and that the claims be allowed.

Applicants note that none of the rejections from the Appeal were maintained so that these rejections have also been withdrawn.

**Conclusion**

In view of the foregoing, the applicant respectfully requests an early Notice of Allowance in the instant application.

Respectfully submitted,



Scott E. Hanf  
Attorney for Applicant  
Reg. No. 38,906

Customer No. 29494  
ROBERT H. HAMMER III, P.C.  
3121 Springbank Lane  
Suite I  
Charlotte, NC 28226  
Telephone: 704-927-0400  
Facsimile: 704-927-0485

H:\2000\083\Amendments after appeal\Amendment-07-15-2004.doc